REMARKS

Claims 1-15 are pending. Claims 1, 7, 9, and 11 are presented for examination. Claims 2-6, 8, 10, and 12-15 have been withdrawn without prejudice or disclaimer. No new matter has been added to this application.

Discussion of Rejection Under 35 U.S.C. § 102(e)

The Examiner rejects claims 1, 7, 9, and 11 under 35 U.S.C. 102(e) as being anticipated by Phan et al. (U.S. Patent Application Publication No. 2003/0003464, which corresponds to U.S. Application Serial No. 09/997,741, hereafter termed "the '741 application"). The Examiner alleges that the reference names a different inventive entity and an earlier effective filing date than the instant invention, and therefore constitutes prior art under 35 U.S.C. § 102(e). Further, the Examiner asserts that the '741 application discloses the claimed method for identifying the presence of a target, comprising "preparing a test sample having target DNA, preparing reporter beads having signal DNA which is complementary to the target, preparing capture beads having transport DNA complementary to the target DNA and having an anchor, blocking the beads with a blocking agent, deposing the beads and test sample into a mixing chamber of an optical bio-disc, rotating the bio-disc allowing the beads to move into the target zone having an anchor agent for the capture agent, removing noncomplexed beads and detecting dual-bead complexes to determine the presence of the target DNA." The Examiner also asserts that the '741 application also anticipates a target RNA.

Applicants respectfully submit that the rejection under 35 U.S.C. § 102(e) is not proper because the cited document is not prior art. The instant invention is a continuation-in-part of the '741 application. Both applications claim priority back to the same provisional application, 60/253,283, which was filed on November 27, 2000. Accordingly, both applications have the same effective filing date.

As the Examiner points out, all of the elements of claims 1, 7, 9, and 11 are present in the '741 application. As noted by the Examiner, the '741 application teaches blocking the beads by adding a blocking agent, such as salmon sperm DNA (see Examples 1 and 2). For example, paragraph 167, lines 4-6 (Example 1), teaches that "pretreatment will reduce the non-specific binding between the capture and reporter beads in the absence of target DNA." The use of a bead

blocking agent is further disclosed, for example, in paragraph 179, lines 3-6 (Example 2), where it is stated that the bead blocking "pretreatment will reduce the non-specific binding between the capture and reporter beads in the absence of target DNA."

In view of the foregoing remarks, Applicants maintain that claims 1, 7, 9 and 11 are fully supported by the documents to which the instant application claims priority. Because the instant application claims priority to the '741 application and both the instant application and the '741 application claim earliest priority to the same provisional application, the claimed invention is not invented by another prior to the date of invention of the claimed subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 102(e) and allowance of the pending claims.

Discussion of Rejection Under 35 U.S.C. § 103(a)

The Examiner rejects claims 1, 7, 9, and 11 under 35 U.S.C. 103(a) as being unpatentable over Virtanen (U.S. Patent No. 6,342,349, hereinafter "the '349 patent"). The Examiner alleges that Virtanen teaches a method for identifying the presence of a target, comprising the steps of "preparing a test sample having target DNA, preparing reporter beads having signal DNA which is complementary to the target, preparing capture DNA complementary to the target DNA and having an anchor, blocking the beads with a blocking agent, deposing the beads and test sample into a mixing chamber of an optical bio-disc, rotating the bio-disc allowing the beads to move into the target zone having an anchor agent for the capture agent, removing non-complexed beads and detecting bead complexes to determine the presence of the target DNA." The Examiner further alleges that Virtanen also teaches target RNA.

A reference that does not disclose each and every element of a claim can be used as prior art under 35 U.S.C. § 103(a); however, the reference must be one that would otherwise qualify as prior art under 35 U.S.C. § 102(a)-(g). Applicants respectfully submit that the '349 patent cannot be used in a § 103(a) rejection because it would not be available as prior art under 35 U.S.C. § 102(a)-(g).

The '349 patent cannot be used in a § 103(a) rejection because it would be available as prior art under § 102(a). In particular, the publication date of the '349 patent is January 29, 2002.

As described above, the priority date of the claimed subject matter disclosed in the instant application is prior to the publication date of the '349 patent.

The '349 patent cannot be used in a § 103(a) rejection because it would not be available prior art under § 102(e) since the instant application and the '349 patent were, at the time the instant invention was made, subject to an obligation of assignment to the same entity. Because the instant application and the '349 patent were commonly owned at the time the invention was made, the Virtanen reference is disqualified as prior art (see, for example, MPEP 706.02(1)(1) and MPEP 706.02(1)(2)).

In view of the foregoing remarks, Applicants respectfully request that the rejection of claims 1, 7, 9, and 11 under 35 U.S.C. 103(a) as being obvious over the '349 patent be withdrawn.

Terminal Disclaimer

The Examiner provisionally rejected claims 1, 7, 9, and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending U.S. Application Serial No. 09/997,741 ('741). Applicants note that because the claims of the '741 application are still being examined, and further because the '741 application has not yet issued, the rejection is provisional. Since the language of either the claims of the instant application or the '741 patent may be modified, a terminal disclaimer may ultimately be unnecessary. A terminal disclaimer will be filed, if necessary, upon resolution of the above-discussed claim rejections under 102(e) and 103(a).

Conclusion

Applicants believe that all outstanding issues in this case have been resolved and that the present claims are in condition for allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is invited to contact the undersigned at the telephone number provided below in order to expedite the resolution of such issues.

No fees are believed due at this time; however, if fees are deemed necessary, please apply any credits or charges, including any fee for an extension of time, to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: September 20, 2005

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